



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/570,557

03/12/2007

Stephan Blicher

0740-78

9949

616

7590

04/16/2008

THE MAXHAM FIRM

9330 SCRANTON ROAD, SUITE 350

SAN DIEGO, CA 92121

EXAMINER

JAIN, ANKUR

ART UNIT

PAPER NUMBER

2618

MAIL DATE

DELIVERY MODE

04/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/570,557	Applicant(s) BLICKER ET AL.	
	Examiner ANKUR JAIN	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 15-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12 March 2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

This application contains claims directed to the following patentably distinct species: **Species 1 – Page 2 lines 10-19 of the newly revised Specification directed towards claim 9; Species 2 – Page 2 lines 20-27 of the newly revised Specification directed towards claims 10-14; Species 3 - Page 5 lines 1-2 of the newly revised Specification directed towards claims 15-16.** The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of

such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is no generic claim.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the

Art Unit: 2618

requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

During a telephone conversation with Mr. Lawrence A. Maxham, a provisional election was made with traverse to prosecute the invention of **Species 2 – Page 2 lines 20-27 of the newly revised Specification directed towards claims 10-14.**

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 9 and 15-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species.

Priority

1. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in the European Patent Office on September 4th, 2003.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed September 17th, 2007 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

3. **Claims 11-14** are objected to because of the following informalities:

(a) The numbering of the claim dependencies does not reflect the most recent claims.

The Examiner is determining the merits of the claims with the presumption that Claim 11 is dependent on Claim 10, Claim 12 is dependent on Claim 11, Claim 13 is

dependent on Claim 10, and Claim 14 is dependent on Claim 11. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 10** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. **Claim 10** recites the limitation "to the previously synchronized PoC application servers" and "by an address derived from the group address" in lines 7-10 of the claim. There is insufficient antecedent basis for these limitations in the claims, and the Examiner is determining the merits of the claim with the presumption that "to the previously synchronized PoC application servers" means "to the previous PoC application server." Also, the Examiner is determining the merits of the claim with the presumption that "by an address derived from the group address" is omitted since there is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 10-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Maggenti et al, US 2002/0077136 A1 (hereafter referenced as Maggenti), in view of Crocker et al, US 2005/0009537 A1 (hereafter referenced as Crocker), and further in view of Bensimon et al, US 2004/0047332 A1 (hereafter referenced as Bensimon).

Regarding **Claim 10**, Maggenti teaches "a method for push-to-talk communication between the members of an existing push-to-talk communication session within a first communication network operated by a first network operator using a Push-to-Talk over a communication system (PoC) application server" (see Abstract, Paragraph 0034, and Figure 3). Maggenti does not teach "a group of an additional communication network operated by a second network operator, using a Push-to-Talk over a communication system (PoC) application server, and also identifying the PoC application server of the additional group." However, Crocker generally teaches "a

Art Unit: 2618

group of an additional communication network operated by a second network operator, using a Push-to-Talk over a communication system (PoC) application server, and also identifying the PoC application server of the additional group” (see Paragraph 0017, Paragraph 0024, and Figure 2). Presence server 161 is read on by the “application server.” It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Maggenti to incorporate a group of an additional communication network operated by a second network operator, using a Push-to-Talk over a communication system (PoC) application server, and also identifying the PoC application server of the additional group as taught by Crocker, for the purpose of enhancing the feasibility and versatility of the wireless communication system by increasing the number of devices utilized and the number of servers. The combination of Maggenti and Crocker does not teach “connecting the additional group to each of the existing groups of the session and synchronizing the application server of the additional group to the previous application server.” However, Bensimon generally teaches “connecting the additional group to each of the existing groups of the session and synchronizing the application server of the additional group to the previous application server” (see Abstract, Paragraph 0021, and Figure 1). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combination of Maggenti and Crocker with the above mentioned limitations as taught by Bensimon, for the purpose of enhancing and increasing system efficiency by introducing the concept of synchronization and by making a connection between the additional group and the existing group.

Regarding **Claim 11 and Claim 12**, the combination of Maggenti and Crocker does not teach “wherein the synchronization is carried out automatically by the PoC application servers.” However, Bensimon generally teaches “wherein the synchronization is carried out automatically by the PoC application servers” (see Abstract, Paragraph 0021, and Figure 1).

Regarding **Claim 13 and Claim 14**, the combination of Maggenti and Crocker does not teach “wherein the synchronization is carried out whenever a user requests update of all group members of the PoC groups before sending a PoC message.” However, Bensimon generally teaches “wherein the synchronization is carried out whenever a user requests update of all group members of the PoC groups before sending a PoC message” (see Abstract and Paragraph 0023). The terminals can “request an update of all group members” when there is subscription sharing. Also, since there is “synchronization” between the servers and between the servers and terminals, the “synchronization can be carried out whenever a user requests update of all group members.”

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ankur Jain whose telephone number is 571-272-9747. The examiner can normally be reached on M-F, 7:30 am to 5:00 pm, EST, Alternate Friday off.

Art Unit: 2618

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lana Le, can be reached on 571-272-7891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ankur Jain/
Examiner, Art Unit 2618
04/10/2008

/Lana N. Le/
Acting SPE of Art Unit 2618